

REMARKS

Applicant respectfully requests reconsideration and allowance of the subject application. Claims 1-25 are pending, of which claims 1, 4, 9, 13, and 16-24 have been amended. The amendments to claims 4, 16, and 18-21 are simply to correct informalities noted by the Applicant, and are not to overcome prior art or any other objection. Support for the amendments can be found at least at p.6 lines 1-23; p.9 lines 1-4; p.10 lines 27-29; p.11 lines 1-3 and 18-20; and at Figs. 1-5 of the subject application.

Applicant's amendments and remarks after Final are appropriate under 37 C.F.R. §1.116 because they address the Office's remarks in the Final Action, and thus could not have been presented earlier. In addition, the amendments and remarks should be entered to place the case in better form for appeal.

15 **35 U.S.C. §102 Claim Rejections**

Claims 1-8 and 24-25 are rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,930,553 to Hirst et al. (hereinafter, "Hirst") (*Office Action* p. 2). Applicant respectfully traverses the rejection.

20 Claim 1 recites an automated warranty fulfillment system for a consumable item that is consumed during operation of a device, the system comprising "computer executable instructions configured to request additional warranty information from a user who initiates a warranty claim for the consumable item and receive the warranty information from the user".

25 Hirst does not show or disclose computer executable instructions configured to request additional warranty information from a user who initiates a warranty claim, as recited in claim 1. The Office cites Hirst for a consumable

having an attached memory device that stores various information associated with the consumable, such as warranty prorating information (*Office Action* pp.2-3; *Hirst* col.3, lines 15-33). However, Hirst does not describe that additional warranty information is requested from a user, as recited in claim 1.

- 5 The Office recognizes that Hirst does not prompt a user for warranty relevant data and does not complete warranty requirements (*Office Action* pp.5-6).

Accordingly, claim 1 is allowable over Hirst for at least these reasons, and Applicant respectfully requests that the §102 rejection be withdrawn.

- 10 Claims 2-8 and 24-25 are allowable by virtue of their dependency upon claim 1 (either directly or indirectly). Additionally, some or all of claims 2-8 and 24-25 are allowable over Hirst for independent reasons. For example:

- Claim 4 recites "a processor disposed on the consumable item, the processor configured to execute the computer executable instructions". Hirst
15 does not specifically describe a processor disposed on a consumable item, as recited in claim 4, and Applicant respectfully disagrees with the Office's contention that a toner level sensor inherently requires a processor (*Office Action* p.3; *Hirst* col.4, lines 39-44). Other types of sensor systems are well-known which do not require a processor disposed on the item.
20 Accordingly, claim 4 is allowable over Hirst and the §102 rejection should be withdrawn.

- Claim 24 recites "additional computer executable instructions configured to perform diagnostic testing of the consumable item to determine whether the consumable item is defective". The Office cites Hirst for the
25 memory of a consumable that can store calibration data which can be used by an image forming device over the life of the consumable (*Office Action* p.4; *Hirst* col.5 lines 13-17). The Office also contends that "calibration is the same

as running a diagnostic test... and resetting some value or variable" (*Office Action* p.4). Applicant disagrees because storing data which can be used by an imaging device for routine calibration of a consumable or a diagnostic test to reset a variable is very different than performing a test to determine if a consumable is defective, as recited in claim 24. It would be of no use to calibrate a defective consumable, or reset a variable of a defective consumable. Accordingly, claim 24 is allowable and the §102 rejection should be withdrawn.

35 U.S.C. §103 Claim Rejections

Claims 9-23 are rejected under 35 U.S.C. §103(a) for obviousness over Hirst in view of U.S. Patent Application Publication No. 2003/0069750 to Siegel et al. (hereinafter, "Siegel") (*Office Action* p. 4). Applicant respectfully traverses the rejection.

Claim 9 recites a method for automating warranty fulfillment for a consumable item that is consumed during operation of a device, the method comprising:

prompting a user of the device for user-provided information corresponding to the consumable item when the user initiates a warranty claim; and

completing warranty requirements with the warranty information, the consumable use data, and the user-provided information to submit the warranty claim for the consumable item.

Hirst and/or Siegel do not teach or suggest prompting a user of the device for user-provided information corresponding to the consumable item when the user initiates a warranty claim, as recited in claim 9. Further, Hirst

and/or Siegel do not teach or suggest completing warranty requirements to submit the warranty claim, as recited in claim 9. The Office acknowledges that Hirst does not prompt a user for warranty relevant data and does not complete warranty requirements (*Office Action* pp.5-6). The Office cites Siegel for automatically registering a product with a product registration service (*Office Action* p.6; *Siegel Abstract*). Siegel emphasizes a registration process which can be completed entirely independently of the consumer and/or additional information may be input by a user and transmitted to the product registration service (*Siegel* ¶¶ 4, 6-8). However, there is no indication in Siegel of prompting a user for information when the user initiates a warranty claim, as recited in claim 9.

Accordingly, claim 9 is allowable over the Hirst-Siegel combination for at least these reasons and Applicant respectfully requests that the §103 rejection be withdrawn.

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Claims 10-16 are allowable by virtue of their dependency upon claim 9 (either directly or indirectly). Additionally, some or all of claims 10-16 are allowable over the Hirst-Siegel combination for independent reasons. For example:

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Claim 13 recites "performing a diagnostic test of the consumable item to determine whether the consumable item is defective." The Office relies only on Hirst for the rejection of claim 13 and has not cited Siegel for the rejection of claim 13. As described above in the response to the rejection of claim 24, it would be of no use to calibrate a defective consumable, or reset a variable of a defective consumable, as the Office contends (*Office Action* p.7). Accordingly, claim 13 is allowable over the Hirst-Siegel combination and the §103 rejection should be withdrawn.

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Claim 17 recites a consumable item for a device comprising “means for interacting with a user to obtain user-provided warranty information corresponding to the consumable item when the user initiates a warranty claim”. The Office rejects claim 17 for the same reasons as claim 9 (*Office Action* pp.4-5). As described above in the response to the rejection of claim 9, Hirst and/or Siegel do not teach or suggest means for interacting with a user to obtain user-provided warranty information corresponding to the consumable item when the user initiates a warranty claim.

Accordingly, claim 17 is allowable over the Hirst-Siegel combination and Applicant respectfully requests that the §103 rejection be withdrawn.

Claims 18-21 are allowable by virtue of their dependency upon claim 17. Additionally, some or all of claims 18-21 are allowable over the Hirst-Siegel combination for independent reasons.

Claims 22-23 are allowable by virtue of their dependency upon claim 1 which is allowable over Hirst for at least the reasons described above in response to the §102 rejection of claim 1. Claims 22-23 are also allowable over the Hirst-Siegel combination because Siegel does not address the deficiencies of Hirst as described above in the response to the rejection of claim 1. Additionally, claims 22-23 are allowable over the Hirst-Siegel combination for independent reasons.

Claim 22 recites “a user interface for display through which the additional warranty information corresponding to the consumable item can be obtained to further complete the warranty requirements”. The Office merely rejects claim 22 on the basis that a user interface would be inherent to prompt a

user for information, and that a user cannot be prompted for information with no interface (*Office Action* p.6). Applicant disagrees because the device (of claim 1) can print a warranty form for the user, as described throughout the specification of the subject application. Accordingly, claim 22 is allowable over the Hirst-Siegel combination and the §103 rejection should be withdrawn.

Claim 23 recites "diagnostic testing of the consumable item to determine whether the consumable item is defective". The Office rejects claim 23 for the same reasons as claim 13 (*Office Action* p.7). As described above in response to the rejection of claims 13 and 24, it would be of no use to calibrate a defective consumable, or reset a variable of a defective consumable, as the Office contends (*Office Action* p.7). Accordingly, claim 23 is allowable over the Hirst-Siegel combination and the §103 rejection should be withdrawn.

Conclusion

Pending claims 1-25 are in condition for allowance. Applicant respectfully requests reconsideration and issuance of the subject application. If any issues remain that preclude issuance of this application, the Examiner is urged to contact the undersigned attorney before issuing a subsequent Action.

Respectfully Submitted,

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